

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Regarding the information disclosure statement, such is submitted herewith. If the information disclosure statement is not in the file when the Examiner picks this case up for action, she is respectfully requested to telephone the undersigned at 212-808-0700 and a copy thereof will be provided immediately.

Regarding the restriction requirement, Applicants acknowledge with appreciation the Examiner's indication that the nonelected subject matter may be rejoined in the event the elected subject matter is found to be allowable.

Claims 17-21 and 23 were rejected under 35 USC § 103(a) as being obvious over Wan et al. ("Wan"), *J. Immunol. Methods*, 162: 1-7 (1993), in view of Cubbage et al. ("Cubbage"), U.S. Patent No. 5,582,982. In response, Applicants point out that the Examiner comments at the top of page 4 of the Office Action as follows:

"Since Wan teaches a fluorescent dye attached to the cell as in the present invention, such fluorescent dye is inherently permeant to the membrane of the cell and detects a voltage across the membrane of the cell."

Applicants whole-heartedly disagree with this statement and the implications thereof. First, Applicants point out that *if* the fluorescent dye is *attached* to the cell, it *cannot* be permeant to the membrane of the cell. Second, the fluorescent dye recited in instant claim 17 and the claims dependent thereupon is *unbound* fluorescent dye which is *not* conjugated to a cell. See, for example, the instant specification at page 4, lines 20-23. Third, Wan's fluorescein conjugated E. coli particles cannot be regarded as a "fluorescent dye," and, thus, does not the terms of the present claims, and, in any case, such particles are clearly *not* permeant to the membrane of any biological cell. Indeed, Wan expressly teaches that the particles *are taken up by phagocytosis*; they do *not* permeate any biological membrane.

In order to make this difference perfectly clear, claim 17 has been amended to require that the fluorescent dye is permeant to the membrane of a biological cell, as stated in claim 21. Claim 21 has further been amended to delete this requirement, which it still retains by its dependence on claim 17. Applicants do not believe that these amendments introduce new matter.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claim 22 was rejected under 35 USC § 103(a) as being obvious over Wan in view of Cubbage and further in view of Van Aken, U.S. Patent No. 5,489,537. In response,

Applicants point out that this rejection was premised on the combination of Wan and Cubbage teaching and/or rendering obvious the basic features of main claim 17. However, Applicants have explained above why this is not, in fact, the case. Accordingly, Applicants submit that the Examiner should reconsider and withdraw this rejection as well. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

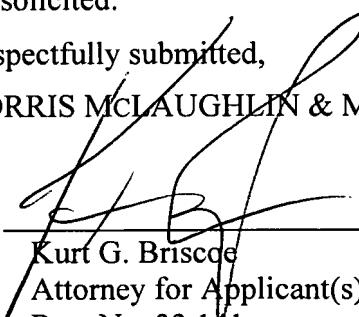
Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,  
NORRIS MC LAUGHLIN & MARCUS, P.A.

By

  
Kurt G. Briscce  
Attorney for Applicant(s)  
Reg. No. 33,141  
875 Third Avenue - 18<sup>th</sup> Floor  
New York, New York 10022  
Phone: (212) 808-0700  
Fax: (212) 808-0844